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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,824

08/25/2003

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16869P-078300US

3627

20350 7590 02/23/2007

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EXAMINER

LE, NANCY LOAN T

ART UNIT

PAPER NUMBER

3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary****Application No.**

10/648,824

**Applicant(s)**

TATSUMI ET AL.

**Examiner**

NANCY T. LE

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-12, 14-17, 19, 21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14-17, 19, 21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Claims*

1. Claims 1-5, 7-12, 14-17, 19, 21 and 23 have been examined.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. §112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

3. Claims 1-5, 7-12, 14-17, 19, 21 and 23 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1, 3, 4, 8, 10, 14, 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. These claims recite **optional language** "if", "**whether ... or not**" without sufficiently providing one of ordinary skill instructions for proceeding in the event at least one of the options/conditions fails.

Therefore, these claims are extremely broad as they are silent regarding what will be done as the "if not" occurs (i.e., as the option/condition fails), hence giving the claims their broadest reasonable interpretation, and a reasonable alternative is "**do nothing**", or "**perform next steps**".

6. Note also that this rationale also applies to subsequent claims that depend from this initial optional/conditional statement, and/or contain an *optional* limitation as language. Thus, all other claims are rejected under 35 U.S.C. §112, second paragraph as they depend from the above-rejected claims.

7. In computer programming, the general form for *optional/conditional* language is:

**if** condition then

begin

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{Executed if condition is true} – in this case, **modifying hardware and program configuration if payment is satisfied**

end

else

begin

{Executed if condition is false}- **applicant does not provide anything if payment is**

**not satisfied**

end;

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

9. Claims 1-5, 7-12, 14-17, 19, 21 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Gold et al.** (US Patent Application Publication No. **2002/0188704**) in view of **Lichtman et al.** (US Patent No. **5,787,246**).

As per claim 1, **Gold et al.** disclose a computer configuration modification method comprising:

- storing hardware configuration information comprising information regarding hardware configuration of a computer, a hardware contract renewal notification destination for the hardware of the computer, information regarding program configuration of the computer, and

a program contract renewal notification destination for the program of the computer [0026, 0030, 0085, 0107];

- upon reception of a configuration modification request for the hardware configuration and program configuration of the computer to be modified, transmitting the information regarding the hardware configuration to be modified to the hardware contract renewal notification destination in order to modify the fee to be paid for the modified hardware, and transmitting the information regarding the hardware configuration to be modified and the information regarding the program configuration to be modified to the program contract renewal notification destination in order to modify the fee to be paid for the modified program [0031, 0079, 0089-0090]; and
- when license information transmitted from the program contract renewal notification destination is inputted, modifying the hardware configuration based on the information regarding the hardware configuration to be modified and modifying the program configuration based on the information regarding the hardware configuration to be modified and the information regarding the program configuration to be modified [0093, 0107].
- receiving billing information for the modified hardware and the modified program (*understood, and implicitly included in "In step 1203, the vendor fulfillment service, **having determined payment details, ...**" – paragraph [0115]. The Office interprets that prior to "having determined payment details ...", billing information has already been received by the Gold's computer configuration modification system for the modified hardware/program*);
- determining whether or not the hardware configuration and program configuration contained in the transmitted license information match with the modified hardware and modified program corresponding to the result as to whether the fee has been paid or not about the billing information ([0093]; *also implicitly included in "In step 1203, the vendor fulfillment service, **having determined payment details, ...**" – paragraph [0115]. The Office also interprets the*

*modified hardware and program configuration corresponding to the received billing information is what is being requested by the customer/client/end-user, and is the same information that was previously/originally registered with the vendor by the customer/client/end-user, and "having determined payment details ..." implicitly includes "determining whether or not the fee/payment has been paid/satisfied"); and*

- if the hardware configuration and program configuration contained in the transmitted license information do not match with the modified hardware and modified program corresponding to the result as to whether the fee has been paid or not about the billing information, then halting the configuration modification of the computer (*[0091, 0093, 0098: the last two sentences, 0100, 0108, 0115]. In paragraph [0093], the Office equates Gold's teaching of "If a match is not found in step 705, then in step 706 the operating system generates an error message that the upgrade license is invalid and enters an invalid upgrade license mode 707" with the claimed invention of "halting the configuration modification of the computer" as it is understood by one of ordinary skill in the art that as the Gold's system generates such an error message about invalid upgrade license and enters an invalid upgrade license mode, then of course, the system stops/halts the upgrade/'configuration modification' process).*

Gold et al. do not expressly disclose when license information transmitted from the program contract renewal notification destination is inputted, modifying the program configuration of the program which operates on the modified hardware based on the information regarding the program configuration to be modified.

Lichtman et al., however, teach when license information transmitted from the program contract renewal notification destination is inputted, modifying the program configuration of the program which operates on the modified hardware based on the information regarding the program configuration to be modified (i.e., A device driver, which enables communications between the

*corresponding device and the computer system, is also identified for each of the devices in response to the device information. In response to the allocation of resources, the identified device drivers are loaded and the devices are activated for operation with the computer – see **Abstract** and **entire prior art**), to enables another program, typically, an operating system (e.g., Windows, Linux, FreeBSD) to interact with a hardware device. (For further reference, according to Wikipedia - the Encyclopedia, "A device driver, or driver for short, is essentially an instruction manual that provides the operating system with the information on how to control and communicate with a particular piece of hardware. In layman's terms, a driver is an important, vital piece to a program application; the main ingredients of the system" (Wikipedia – The Free Encyclopedia, [http://en.wikipedia.org/wiki/Device\\_driver](http://en.wikipedia.org/wiki/Device_driver))).*

Therefore, it would have been obvious and motivated to one of ordinary skill in the art at the time of the applicant's invention to modify a computer configuration modification method as disclosed by Gold et al. to include "modifying the program configuration of the program which operates on the modified hardware based on the information regarding the modified hardware ...", taught by Lichtman et al., to enable communications/interactions between the corresponding device and the computer system, typically, the operating system (Wikipedia – The Free Encyclopedia, [http://en.wikipedia.org/wiki/Device\\_driver](http://en.wikipedia.org/wiki/Device_driver)).

As per claim 2, Gold et al. in view of Lichtman et al. disclose the computer configuration modification method according to claim 1, wherein the license information includes a license key, and wherein the hardware configuration and the program configuration of the computer are modified based on the license key (Gold, [0007-0008, 0060-0062, 0085, 0093] and fig. 7).

As per claims 3 and 10, Gold et al. in view of Lichtman et al. disclose the computer configuration modification method according to claims 2 and 9, respectively, further comprising: "*making a determination as to whether or not to perform the configuration modification based on a period of validity comprised in the license key*" (Gold, [0018-0019, 0027-0028, 0032, 0085: second sentence, 0106]).

As per **claim 4**, Gold et al. in view of Lichtman et al. disclose the computer configuration modification method of claim 2, further comprising:

- comparing the hardware configuration with the license key [*Gold, 0093*];
- if the license key contains a permissible hardware amount which is smaller than an actual hardware amount of the hardware configuration, then modifying a hardware amount used by the program of the computer to the permissible hardware amount indicated by the license key [*Gold, 0096-0097*]; and
- if the license key contains a permissible hardware amount which is greater than the actual hardware amount of the hardware configuration, then modifying a hardware amount used by the program of the computer to the actual hardware amount of the hardware configuration [*Gold, 0098, 0111*].

As per **claim 5**, Gold et al. in view of Lichtman et al. disclose the computer configuration modification method according to claim 1, wherein when the configuration modification is performed, the configuration of the program is modified based on the modified hardware configuration (*Gold, [0098, 0100] in view of Lichtman, Abstract*).

As per **claim 7**, Gold et al. in view of Lichtman et al. disclose the computer configuration modification method according to claim 1, wherein the hardware configuration is modified when license information transmitted from the hardware contract renewal notification destination and license information transmitted from the program contact renewal notification destination are inputted [*Gold, 0093, 0107*].

As per **claim 8**, Gold et al. in view of Lichtman et al. disclose that in a computer readable medium containing a computer configuration modification program for modifying configuration of a computer, the computer configuration modification program comprising:



- code for storing hardware configuration information comprising information regarding hardware configuration of a computer, a hardware contract renewal notification destination for the hardware of the computer, information regarding program configuration of the computer, and a program contract renewal notification destination for the program of the computer (*see claim 1 for citation*);
- code for, upon reception of a configuration modification request for the hardware configuration and program configuration of the computer to be modified, transmitting the information regarding the hardware configuration to be modified to the hardware contract renewal notification destination in order to modify the fee to be paid for the modified hardware, and transmitting the information regarding the hardware configuration to be modified and the information regarding the program configuration to be modified to the program contract renewal notification destination in order to modify the fee to be paid for the modified program (*see claim 1 for citation*); and
- code for modifying the hardware configuration based on the information regarding the hardware configuration to be modified and modifying the program configuration based on the information regarding the hardware configuration to be modified and the information regarding the program configuration to be modified, when license information transmitted from the program contract renewal notification destination is inputted (*see claim 1 for citation*);
- code for determining whether or not the hardware configuration and program configuration contained in the transmitted license information match with the modified hardware and modified program corresponding to the received billing information (*see claim 1 for citation*);
- code for halting the configuration modification of the computer, upon determining that the hardware configuration and program configuration contained in the transmitted license information do not match the modified hardware and modified program corresponding to the

result as to whether the fee has been paid or not about the billing information (*see claim 1 for citation*).

As per **claim 9**, Gold et al. in view of Lichtman et al. disclose the computer configuration modification program according to claim 8, wherein the code for modifying comprises code for modifying the configuration of the computer based on a license key which is included in the license information [*Gold, 0060-0062, 0085, 0093, & fig. 7*].

As per **claim 11**, Gold et al. in view of Lichtman et al. disclose the computer configuration modification program according to claim 9, further comprising:

- code for comparing the hardware configuration with the license key [*Gold, 0093*];
- code for modifying a hardware amount used by the program of the computer to the permissible hardware amount indicated by the license key, upon determining that the license key contains a permissible hardware amount which is smaller than an actual hardware amount of the hardware configuration [*Gold, 0096-0097*]; and
- code for modifying a hardware amount used by the program of the computer to the actual hardware amount of the hardware configuration, upon determining that the license key contains a permissible hardware amount which is greater than the actual hardware amount of the hardware configuration [*Gold, 0098, 0111*].

As per **claim 12**, Gold et al. in view of Lichtman et al. disclose the computer configuration modification program according to claim 8, wherein the code for modifying comprises code for modifying the program configuration based on the modified hardware configuration when the configuration modification is performed [*Gold, 0098, 0100 in view of Lichtman, Abstract*].

As per **claim 14**, Gold et al. disclose a computer configuration modification device comprising:

- a memory configured to store hardware configuration information comprising: information regarding hardware configuration of a computer, a hardware contract renewal notification destination for the hardware of the computer, information regarding program configuration of the computer, and a program contract renewal notification destination for the program of the computer (*see citation for claim 1*);
- means, upon reception of a configuration modification request for the hardware configuration and program configuration of the computer to be modified, for transmitting the information regarding the hardware configuration to be modified to the hardware contract renewal notification destination in order to modify the fee to be paid for the modified hardware, and transmitting the information regarding the hardware configuration to be modified and the information regarding the program configuration to be modified to the program contract renewal notification destination in order to modify the fee to be paid for the modified program (*see citation for claim 1*); and
- means, when license information transmitted from the program contract renewal notification destination is inputted, for modifying the hardware configuration based on the information regarding the hardware configuration to be modified and modifying the program configuration based on the information regarding the hardware configuration to be modified and the information regarding the program configuration to be modified (*see citation for claim 1*);
- means for determining whether or not the hardware configuration and program configuration contained in the transmitted license information match with the modified hardware and modified program corresponding to the billing information for the modified hardware and program (*see claim 1 for citation*);
- means, if the hardware configuration and program configuration contained in the transmitted license information do not match the modified hardware and modified program corresponding to the result as to whether the fee has been paid or not about the billing information, for halting the configuration modification of the computer (*see citation for claim 1*);

As per claim 15, Gold et al. in view of Lichtman et al. disclose the computer configuration modification device according to claim 14, further comprising means for modifying the configuration of the computer based on a license key which is included in the license information [Gold, 0060-0062, 0085, 0093, & fig. 7].

As per claim 16, Gold et al. in view of Lichtman et al. disclose the computer configuration modification device according to claim 15, wherein the license key includes a period of validity for modifying the configuration of the computer [Gold, 0018-0019, 0027-0028, 0032, 0085: second sentence, 0106].

As per claim 17, Gold et al. in view of Lichtman et al. disclose the computer configuration modification device according to claim 15, further comprising:

- means, if the license key contains a permissible hardware amount which is smaller than an actual hardware amount of the hardware configuration, for modifying a hardware amount used by the program of the computer to the permissible hardware amount indicated by the license key [Gold, 0096-0097], and if the license key contains a permissible hardware amount which is greater than the actual hardware amount of the hardware configuration, for modifying a hardware amount used by the program of the computer to the actual hardware amount of the hardware configuration [Gold, 0098, 0111].

As per claim 19, Gold et al. in view of Lichtman et al. disclose a computer configuration modification system comprising:

- a computer having a modifiable configuration [Gold, 0007-0009];
- a hardware management system configured to perform billing in accordance with hardware configuration of the computer [Gold, 0115]; and

- a program management system configured to perform billing in accordance with the program configuration of the computer *[Gold, 0115]*;
- wherein the computer is configured, when a configuration modification request for the hardware configuration and program configuration of the computer is inputted, to transmit to the hardware management system information regarding the hardware configuration to be modified in order to modify the fee to be paid for the hardware following configuration modification, and to transmit to the program management system information regarding the program configuration to be modified together with the information regarding the hardware configuration to be modified in order to modify the fee to be paid for the program following configuration modification *[Gold, 0031, 0079, 0089-0090]*;
- wherein the hardware management system is configured, when the information regarding the hardware configuration to be modified is inputted, to modify the fee to be paid for the hardware based on the hardware configuration information and to transmit hardware billing information to the computer *[Gold, 0031, 0079, 0089-0090]*;
- wherein the program management system is configured, when the information regarding the hardware configuration to be modified and the information regarding the program configuration to be modified is inputted, to modify the fee to be paid for the program based on the hardware configuration information and program configuration information and to transmit program billing information to the computer *[Gold, 0031, 0079, 0089-0090]*; and
- wherein the computer is configured, when the hardware billing information and the program billing information are inputted, to modify the hardware configuration based on the information regarding the hardware configuration to be modified and to modify the program configuration based on the information regarding the program configuration to be modified *[Gold, 0093, 0107]*;

- wherein the hardware configuration and the program configuration of the computer are modified based on a license key generated by the program management system [*Gold, 0060-0062, 0085, 0093, & fig. 7*];
- wherein the license key contains permissible hardware configuration and permissible program configuration [*Gold, 0093*], and wherein the computer is configured not to modify the hardware configuration and the program configuration if the hardware configuration and the program configuration corresponding to the result as to whether the fee has been paid or not about the billing information do not match the permissible hardware configuration and the permissible program configuration contained in the license key [*Gold, 0091, 0093, 0098: the last two sentences, 0100, 0108*].

As per **claim 21**, Gold et al. disclose the computer configuration modification system according to claim 20, wherein the license key includes a period of validity for modifying the configuration of the computer [*Gold, 0018-0019, 0027-0028, 0032, 0085: second sentence, 0106*].

As per **claim 23**, Gold et al. disclose the computer configuration modification system according to claim 19, wherein the computer is configured to modify the program configuration based on the modified hardware configuration [*Gold, 0098, 0100*].

### **Conclusion**

10. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is **(571) 272-7066**. The examiner can normally be reached on Monday - Friday, 9am - 6:00pm Eastern Standard Time.
12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW J. FISCHER can be reached on **(571) 272-6779**.
13. **For official/regular communication**, the fax number for the organization where this application or proceeding is assigned is **(571) 273-8300**.
14. **For informal/draft communication**, the fax number is **(571) 273-7066 (Rightfax)**.
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197 (toll-free)**.




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Nancy Le

Patent Examiner

16 February 2007



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